

REMARKS

Prior Art Rejections

Claims 1-4 and 9-11 have been rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Koeske et al. (US 6,250,613). This rejection is respectfully traversed for the following reasons.

Koeske et al is being applied as art under 35 U.S.C. § 102(b). Koeske et al is not applicable art under 35 U.S.C. §102(b). To be applicable under 102(b), Koeske et al must have issued or been published more than one year prior to the effective filing date of the present application. Koeske et al, US 6250613 B1, was issued on June 26, 2001. The present application entered into the US patent system under the PCT National Stage on November 6, 2001. This date is not more than one year after the grant of US 6250613.

While the National Stage entry date of the present application is more than one year after the earliest publication of Koeske (the earliest publication date of Koeske being EP 1 041 308 A1 on February 23, 2000), there are still two deficiencies to holding Koeske as applicable under 102(b). First, it is not the European publication being used in the present rejection. Second, because Applicant entered the US patent system under the PCT National Stage, under 371, as shown on the filing receipt, Applicant is entitled to the International Filing Date as his 102(e) date; thus Applicant has a filing date of May 28, 1999 (see MPEP 1893.03(b)), prior to publication of EP 1 041 308 A1 and less than 2 months after the filing date of US 6250613.

Thus Koeske et al is only available under 35 U.S.C. 102(e). Koesket et al was already applied in a rejection under 35 U.S.C. 102(e), in the Office Action of March 26, 2003, rejecting claims 1, 3, and 4, maintained in the June 9, 2003 rejection, but presumably withdrawn as the rejection was not maintained in the next Office Action of September 8, 2003.

Since Koeske et al is not applicable under 102(b), the present rejection will be treated as under 102(e) and in the alternative 103(a).

Under 35 U.S.C. § 102, the reference must disclose *each and every* element recited in the claims by Applicant. In the rejection it is asserted that "the assembled air spring of Koeske et al provides an integrally formed or unitary retainer/intermediate ribbed reinforcement structure." It appears to be suggested in the rejection that the "unitary" or "integral" nature of the ribbed retainer of Koeske et al occurs *after* assembly of the air spring and not prior to assembly. Applicant

discloses in the specification and has made it clear through numerous arguments that the unitary and/or integral nature of the recited ribbed retainer is achieved prior to assembly of the air spring. Koeske et al does not disclose such a construction. The spacer and the retainer of Koeske et al are not integrally formed into a single retainer. Claim 1 recites that the ribbed reinforcement structure strengthens the retainer. It is questionable how the separate ribbed spacer of Koeske et al, can provide the recited strengthening aspect to the retainer.

Recognizing that the Applicant's recited ribbed retainer may be manufactured as a single piece, it is argued in the Office Action that "it follows that prior to the introduction of Koeske et al.'s spacers, the industry provided retainers with ribbed reinforcement structure built right in" and thus it is held that a ribbed reinforcement structure is inherent to the disclosure. This argument is wholly unsupported by any facts in Koeske et al or additional prior art, but fueled solely by speculation – not a permissible line of reasoning or logic in maintaining a rejection in a patent application. Had Koeske et al provided a prior art drawing of a prior art air spring that showed a ribbed retainer, this argument might be supportable. However, Koeske et al does no such thing. Nor has the Examiner provided any prior art to support such a position.

All that Koeske et al teaches that occurred prior to his invention is that the industry was "forced to provide each air spring configuration in a variety of heights and diameters" (col 1, lines 49-51). This in no way remotely suggests that the end caps (as the retainers are called by Koeske et al) were designed as ribbed structures. All Koeske et al teaches is that the air springs had to have different heights – Koeske et al does *not* imply or inherently infer the use of ribbed retainers to achieve the different heights.

It is also held that "providing a one-piece retainer/ribbed reinforcement structure fails to demonstrate such insight since arrival at such a structure requires merely practicing what was known prior to making retainers and ribbed reinforcement structure separately." This holding is based on Examiner's assertion that the industry must have provided ribbed retainers prior to Koeske et al – an assertion that is unsupported by any prior art, and only supported by mere speculation. The duty to show lack of novelty or non-obviousness based upon prior art is upon the Examiner – and the Examiner has not met this burden herein.

It appears that an attempt is made to shift the burden back to Applicant to prove “insight contract to the understands and expectations of the art” to rise above what is held in the rejection as an obvious engineering choice to provide a structure that “requires merely practicing what was known prior to making retainers and ribbed reinforcement structures separately.” For the burden of proof to first be shifted to Applicant, the Examiner must first meet his burden of proof in showing that the prior art teaches what is being asserted in the rejection – this has not been met. As noted above, absolutely no prior art has been provided to support the rejection; only speculation as to what might have occurred. Given the plethora of patents regarding airsprings, should the structure asserted in the rejection have existed prior to Koeske, than such patents or other prior art should be provided – not merely suggested.

A case of *prima facie* obviousness has not been established herein. It is requested that the Examiner re-examine his position and either support it by a showing of additional prior art to support his position or withdraw the rejection of the claims over Koeske.

As Koeske et al is not prior art available under 35 U.S.C. § 102(b), fails to disclose each and every recited element under 35 U.S.C. § 102(e) and the Examiner has failed to provide any prior art to support his speculative argument for obviousness under 35 U.S.C. § 103, it is requested that the above rejections be withdrawn.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al. in view of Geno et al. (U.S. 4,946,144).

The rejection of these claims are based on Koeske et al. The examiner has failed to establish *prima facie* obviousness of claim 1 as required under 35 U.S.C. § 103. Any rejection of the dependent claims also fails to achieve *prima facie* obviousness.

It is noted that the Examiner has chosen to not address any arguments presented in the Appeal Brief “in view of the new ground(s) of rejection.” The rejections presented in the February 26th Office Action are *not* new grounds – the same prior art is being applied and being applied in the same manner as in previous office actions. The only difference is the new speculation regarding prior industry practice – an argument unsupported by any prior art.

Declaration under 37 CFR 1.131

As the Examiner has chosen of his own volition to pull the application from Appeal and issue another rejection, Applicant has chosen to submit a Declaration under 37 CFR 1.131, with appropriate supporting exhibits, to establish invention of the subject matter prior to the effective date of Koeske et al (March 30, 1999).

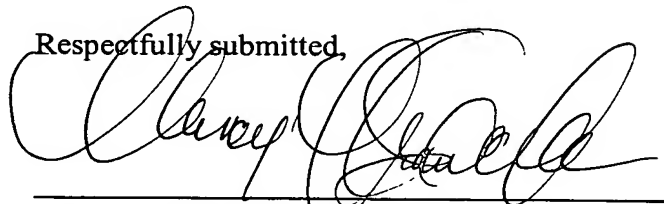
As sworn to in the Declaration, Applicant originally conceived of the idea of a ribbed retainer in early September 1997. The original design had interference problems and Applicant, still employing the concept of a ribbed retainer, redesigned the retainer. The redesigned retainer was created on or about May 27, 1998 – well before Koeske et al's filing date of March 30, 1999. Following creation of the redesigned retainer, Applicant tested the retainer structure to ensure that the new design met the necessary testing and performance specifications.

Per 37 CFR 1.131(b), the facts set forth in the Declaration and exhibits presented establish reduction to practice prior to the filing date of Koeske et al.

As Applicant has established reduction to practice prior to Koeske et al and there was no intent of abandonment prior to the filing date of the present application, it is requested that Koeske et al be withdrawn as applicable prior art.

In light of the arguments and the Declaration submitted, Applicant believes that all the claims pending in the subject patent application are allowable. Thus, the Examiner is respectfully requested to allow all pending claims.

Respectfully submitted,



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